



11/2/03 1631
Docket No.: PA-0044 US

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Printed: Jeannie G. Labra

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jones et al.

Title: GENES REGULATED BY DNA METHYLATION IN TUMOR CELLS

Serial No.: 10/051,835

Filing Date: January 16, 2002

Examiner: S. Zhou

Group Art Unit: 1631

Mail Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return Receipt Postcard; and
2. Response to Restriction Requirement (4 pp.).

The fee has been calculated as shown below.

| Claims | Claims After Amendment | - | Claims Previously Paid For | = | Present Extra | Other Than Small Entity Rate | Fee | Additional Fee(s) |
|--|---------------------------|---|----------------------------------|---|---------------|------------------------------------|-----|-------------------|
| Total | 20 | - | 20 | = | 0 | x\$18.00 | | \$ 0 |
| Indept. | 3 | - | 3 | = | 0 | x\$86.00 | | \$ 0 |
| First Presentation of Multiple Dependent Claims: | | | | | | +290.00 | | \$ |
| Total Fee: | | | | | | | | \$ 0 |

☒ No additional Fee is required.

☐ Please charge Deposit Account No. **09-0108** in the amount of : \$ _____

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. 09-0108. **A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

INGYTE CORPORATION

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By: 

Printed: Jeannie G. Labra

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Lasek et al.

Title: GENES REGULATED BY DNA METHYLATION IN TUMOR CELLS

Serial No.: 10/051,835

Filing Date: January 16, 2002

Examiner: S. Zhou

Group Art Unit: 1631

Mail Stop Non-Fee Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated October 3, 2003, setting a 30-day/one (1) month term for response.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-6) drawn to an array of polynucleotides.

Group II (claims 7-9) drawn to a high throughput method for detecting differential expression of genes.

Group III (claims 10-11) drawn to a high throughput method for screening a plurality of molecules to identify a compound that specifically binds to a cDNA.

Group IV (claims 12-14) drawn to a polynucleotide or vectors or host cells containing same.

Group V (claim 15) drawn to a method of making a protein.

Group VI (claim 16) drawn to a polypeptide or protein.

Group VII (claims 17-18) drawn to a method of using a protein to screen a library to find compounds that bind the protein.

Group IX (claim 19) drawn to a method of making an antibody.

Group X (claim 20) drawn to an antibody.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-6. Applicants submit that the polynucleotides of Group I could be examined together with their methods of use as recited in claims 7-9 and 10-11, Groups II and III, respectively, without undue burden considering that they depend from and are of the same scope as the polynucleotide combination claims 1-6. Applicants further submit that the polynucleotide composition of matter claims, claims 12-14 of Group IV and their method of use in making a protein could also be examined together with Groups I-III without and additional burden of search. The MPEP at 803.04, gives examples of nucleotide sequence claims containing independent nucleotide sequences recited in the alternative form (Example (A) in MPEP 803.04), and combination claims (Examples (B) and (C) in MPEP 803.04), as in Groups IV (claims 12-14) and I (claims 1-6), respectively, of the instant application. The MPEP then considers proper restriction in those instances as follows:

In applications containing all three claims set forth in examples (A)-(C), **the Office will require restriction of the application to ten sequences for initial examination purposes.** Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed.

Rejoinder will be permitted for claims requiring any allowable sequence(s). Any claims which have been restricted and nonselected and which are limited to the allowable sequence(s) will be rejoined and examined. (Emphasis added)

Proper restriction practice in the present case would allow examination of the combination claims of Group I together with the composition of matter claims of Group IV without undue burden by examining the ten sequences recited in claim 12 (SEQ ID NOs:1, 11-18, and 25) with respect to the patentability of both groups of claims. It is noted that at the bottom of page 5 of the present restriction requirement, the Examiner states that: “a fully responsive communication will comprise a proper election of a group and a sequence as set forth above” (emphasis added). However, no such sequence election is set forth anywhere previously in the Office communication.

Applicants therefore request reconsideration of the restriction requirement and examination of all of claims 1-15 in Groups I-V. In the event the Examiner maintains the restriction requirement, applicant will, at a later time, request rejoinder of any combination or composition of matter claims previously restricted, but later found to contain allowable sequences, in accordance with MPEP 803.04, above. Applicants will also ask for rejoinder of any method claims limited in scope to allowed combination or composition of matter claims in accordance with *in Re Ochiai* and the MPEP 821.04. Finally, Applicants reserve the right to prosecute the subject matter of all other non-elected claims in subsequent divisional applications.

CONCLUSION

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

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